REMARKS/ARGUMENTS

Claims 1-12 are pending in the application. Claims 10-12 have been added. Support for Claims 10-12 can be found in the specification, at least at page 4. No new matter has been entered by amendment. Reexamination and reconsideration of the claims are respectfully requested.

The Restriction Requirement Should be Withdrawn

The Examiner has imposed a restriction requirement under 35 U.S.C. § 121 between Claims 1-8 (Group I) and Claims 8 and 9 (Group II). The Examiner's Group I (Claims 1-8) is elected with traverse.

Applicants submit that restriction is improper in this instance as claims to a process and a product made by that process are not distinct inventions. Indeed, the Examiner argues that the product and method of making the product are distinct inventions because the method of making the golf ball does not require the specifics of the location-determining chip. However, in each of Claims 8-12, the identification device or components thereof (coded element and an aerial) is/are encapsulated in a capsule member. Thus, each method claim currently pending must result in the production of the claimed golf ball products.

The Rejection Under 35 U.S.C. § 102 Should Be Withdrawn

Claims 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,743,815 (hereinafter "Helderman").

One technical problem of the prior art that is solved by the present invention is provision of a sufficiently reliable identification device robust enough to withstand the shock of repeated impacts with a golf club (pending specification, page 1, paragraph 4). Pending Claims 8 and 9 are directed to a method of manufacture of a golf ball in which the identification device is protected against mechanical shocks. Specifically, the method of claim 8 includes the steps of molding an identification device in a disc or capsule member characterized in that means for protecting the identification device from the effects of impacts are also molded in the disc or capsule member. The capsule provides high impact absorption and bonding for the identification

device (pending specification, page 4, paragraph 1). Additionally, a ball manufactured as claimed is advantageously within the normal weight specification and performs exactly as a normal golf ball (pending specification, page 4, last paragraph).

Helderman does not teach or suggest means for protecting an identification device moulded in the disc or capsule. With reference to the Helderman specification, the transponder is encapsulated in glass (16) which hermetically seals the transponder and holds its components in place to help prevent damage from shock (Helderman specification, column 3 lines 20 to 26). This arrangement does not offer sufficient protection from the effects of impacts. Additional protection is achieved by a complex arrangement outside of the capsule as clearly distinct from the presently claimed golf ball and method of making the same wherein the protection is molded into the capsule. For additional protection, the capsule is slid into silicone tubing (22) which is then slid into an aluminium tube (18). The aluminium tube (18) has apertures at each end of the tube and a slit (20) running the length of the tube so that the transponder can receive energy from a remote electro magnetic field. However, the impact of a golf club will close the slit, so an additional spacer (20) is required.

Claim 9 is directed to the core of the golf ball having a cuboid shape and being subsequently processed to have a spherical shape. One advantage of the core initially having a cuboid shape is that special cutting tools are not required because the core is pre-manufactured in this shape (pending specification, page 4, paragraph 2). The core can be sliced in half, the capsule placed at the center and the two halves bound back together. This can be done manually. This feature is not disclosed in Helderman.

Because Helderman neither teaches nor suggests means for protecting the identification device molded in the disc or capsule as required by pending Claims 8 and 9, the rejection under 35 U.S.C. § 102(e) should be withdrawn.

The Claim Rejections Under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being obvious over Helderman in view of U.S. Patent No. 6,212,949 (hereinafter "Boiron").

device (pending specification, page 4, paragraph 1). Additionally, a ball manufactured as claimed is advantageously within the normal weight specification and performs exactly as a normal golf ball (pending specification, page 4, last paragraph).

Helderman does not teach or suggest means for protecting an identification device moulded in the disc or capsule. With reference to the Helderman specification, the transponder is encapsulated in glass (16) which hermetically seals the transponder and holds its components in place to help prevent damage from shock (Helderman specification, column 3 lines 20 to 26). This arrangement does not offer sufficient protection from the effects of impacts. Additional protection is achieved by a complex arrangement outside of the capsule as clearly distinct from the presently claimed golf ball and method of making the same wherein the protection is molded into the capsule. For additional protection, the capsule is slid into silicone tubing (22) which is then slid into an aluminium tube (18). The aluminium tube (18) has apertures at each end of the tube and a slit (20) running the length of the tube so that the transponder can receive energy from a remote electro magnetic field. However, the impact of a golf club will close the slit, so an additional spacer (20) is required.

Claim 9 is directed to the core of the golf ball having a cuboid shape and being subsequently processed to have a spherical shape. One advantage of the core initially having a cuboid shape is that special cutting tools are not required because the core is pre-manufactured in this shape (pending specification, page 4, paragraph 2). The core can be sliced in half, the capsule placed at the center and the two halves bound back together. This can be done manually. This feature is not disclosed in Helderman.

Because Helderman neither teaches nor suggests means for protecting the identification device molded in the disc or capsule as required by pending Claims 8 and 9, the rejection under 35 U.S.C. § 102(e) should be withdrawn.

The Claim Rejections Under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being obvious over Helderman in view of U.S. Patent No. 6,212,949 (hereinafter "Boiron").

Claim 1 is directed to a golf ball having an embedded identification device comprising an aerial and a coded element wherein a spring or diaphragm is connected to the coded element and/or aerial to dampen mechanical shocks. The identification device is molded in a capsule which is then placed at the center of a golf ball core. As the material of the capsule sets, the distinct thermal setting properties of the different materials enables the diaphragm to "set back," giving room for relative movement after setting (pending specification, page 4, paragraph 1). Because the coded element/aerial is connected to a resilient member within the capsule, there is no need to surround the capsule with the arrangements described in the prior art. The capsule can be placed at the center of a standard rubber golf club core, there is no need for the core to be, for example, gel or liquid filled.

Helderman discloses golf balls having an embedded identification device housed within a protective casement or capsule, and additional protective means included around the capsule to protect against mechanical shock. Further, the golf ball of Helderman comprises a transponder, the components of which are held in place by a rigid glass capsule (Helderman specification, column 3 lines 24-26). The capsule is then wrapped in a layer of elastic material such as silicon, which is surrounded by a rigid housing such as aluminium tubing (Helderman abstract). Helderman does not disclose a coded element and/or aerial of an identification device connected to a diaphragm or spring as required by pending Claim 1. Thus, the identification device of Helderman is not connected to a resilient member. Furthermore, there is nothing in the disclosure that would lead a skilled person to include a resilient member in the capsule. The skilled artisan would not be motivated to open up the Helderman capsule to improve shock resistance as Helderman states that the capsule itself prevents shock damage by hermetically sealing the transponder (Helderman specification, column 3 lines 20 to 26). Thus, Claim 1 is not obvious in light of Helderman.

Boiron addresses an entirely different technical field directed to a gambling chip with an identification device. Protection of the identification device is achieved by forming a monobloc

rigid assembly (Boiron specification, column 1, paragraph 7). However, the identification device is not connected to a resilient member.

Thus neither prior art document cited by the Examiner discloses a spring or diaphragm connected to the aerial or coded element of the identification device to dampen mechanical shocks as required by pending Claim 1. A skilled person addressing the problem of impact resistance in golf balls would not look to the field of gambling chips to solve the problem as gambling chips are not exposed to the degree of mechanical force exerted on a golf ball when hit. Furthermore, even if the skilled person did combine the references, the combination of the Helderman and Boiron references does not teach all of the limitations of the present invention, as claimed.

Applicants submit that there is no suggestion or motivation in the references to make the combination and that the combination does not teach every limitation of the pending claims. Therefore, the rejection under 35 U.S.C. § 103(a) be withdrawn.

Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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